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IN THE

Supreme Court of the United States

October Term, 1958.

No. [redacted] 142

CHAS. PFIZER & CO., INC.,
Petitioner,

v.

G. D. SEARLE & CO.,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

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June 25, 1959.

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

To the Honorable Earl Warren, Chief Justice, and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Chas. Pfizer & Co., Inc., respectfully prays that a writ of certiorari issue to review a final judgment of the United States Court of Appeals for the Seventh Circuit reversing a judgment for petitioner entered by the United States District Court for the Northern District of Illinois, in an action for trademark infringement and unfair competition entitled *G. D. Searle & Co. v. Chas. Pfizer & Co., Inc.*, Civil Action No. 53 C 2407. The aforesaid judgment by the court of appeals set aside the findings of fact by the district court, made contrary findings of fact, and directed the district court to issue an injunction restraining petitioner from using its trademark BONAMINE on a motion sickness remedy.

The trial court had previously found, on substantial credible evidence adduced during the trial, that petitioner's trademark BONAMINE and respondent's trademark DRAMAMINE are "unlike", thereby disposing of the ultimate factual issue involved in the case, i.e.—whether petitioner's mark was likely to be confused with respondent's mark. This finding alone was dispositive of the case, but the trial court also made subsidiary findings from the evidence adduced in open court, that (a) the common "amine" suffix of both trademarks accurately described the chemical and physiological nature of each product, (b) numerous pharmaceutical products had been sold for years under trademarks with an "amine" suffix, (c) the trademarks do not sound alike, (d) the products differ from each other in color, in size, and in packaging, and (e) the products are purchased with great care. (J. A. 1278-1279; App. B, *infra*, 10a-11a.)

The appellate court ignored the substantial evidence on which these findings were bottomed, arbitrarily categorized the ultimate finding as "clearly erroneous", and treated the remaining findings as inadequate or nonexistent. Moreover, although the appellate court had no opportunity to see or to appraise the credibility of the witnesses, it then proceeded to resolve conflicting testimony and make its own findings of fact—instead of remanding the action to the trial court for supplemental findings. In doing so, it ignored the undisputed facts of record, that the only common portion of the two trademarks—the "amine" suffix—was in the public domain as a generic or descriptive name of the class of chemicals to which both products belong; and that this suffix has long been widely used in trademarks for medicinal products, including antihistamines and motion sickness remedies.

OPINIONS BELOW.

The district court's opinion in prior proceedings on petitioner's motion for summary judgment (App. B, *infra*, 2a) is reported in 130 F. Supp. 811. The opinion of the court of appeals remanding the cause for trial (App. B, *infra*, 4a) is reported in 231 F. 2d 316. After the trial, the district court filed no opinion as such, but filed findings of fact and conclusions of law (J. A.[1] 1277; App. B, *infra*, 9a) which are reported in 159 F. Supp. 878. The opinion of the court of appeals on the second appeal (App. B, *infra*, 12a) is reported in 265 F. 2d 385.

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1. The record filed with this petition comprises certified copies of the documents listed below. References to pages of each document will be prefixed by the identifying letters shown:

Identifying Prefix	*Name of Document*	*Date Filed in Court of Appeals*
J.A.	Joint Appendix (2 volumes)	August 11, 1958
D.A.	Defendant-Appellee's Appendix [Bound with Brief of Appellee]	September 29, 1958
P.A.	Plaintiff-Appellant's Appendix [Bound with Reply Brief of Appellant]	October 14, 1958
Op.	Opinion of Court of Appeals [Certified with Joint Appendix]	March 26, 1959
(None)	Order of Court of Appeals on Opinion [Certified with Joint Appendix]	March 26, 1959
(None)	Order of Court of Appeals denying rehearing [Certified with Joint Appendix]	April 28, 1959

QUESTIONS PRESENTED.

1. Where the evidence indisputably establishes that two trademarks for motion sickness remedies contain a common suffix which is in the public domain and which accurately describes each product, coupled with dissimilar prefixes, may a finding of fact by the trial court that the trademarks are "unlike" be set aside by the appellate court as being "clearly erroneous"?

2. Where a trademark owner concedes that its charge of infringement is based upon supposed similarity of sounds, may a specific finding of fact by the trial judge that the trademarks are not acoustically similar, which is supported by substantial credible evidence, including testimony of expert and other witnesses and observations by the trial judge as to the manner of pronunciation of the words by counsel and witnesses throughout the proceedings, be ignored on the novel theory that the trial judge applied "a side by side comparison" of sounds which is "not a correct test" for acoustic similarity?

3. Where findings of fact made by a trial judge who has heard witnesses testify in person during a long trial are held to be insufficient, should the cause be remanded to the trial court for supplemental findings of fact or may the appellate court resolve sharp conflicts in the evidence and make its own findings from the paper record?

JURISDICTION.

The judgment of the court of appeals was entered on March 26, 1959. Timely petition for rehearing was filed by petitioner on April 10, 1959, which was denied on April 2, 1959. The jurisdiction of this Court is invoked under 28 U. S. C. § 1254(1).

STATUTES INVOLVED.

The statutory provisions involved are Sections 32(1) and 45 of the Trademark Act of 1946, 15 U. S. C. §§ 1114(1) and 1127; and Rule 52(a) F. R. C. P. They are printed in Appendix A (*infra*, 1a).

STATEMENT.

In the district court petitioner was charged with infringement of respondent's registered trademark DRAMAMINE arising from petitioner's use of its trademark BONAMINE for a motion sickness remedy sold in competition with that of respondent. The unfair competition charge was based on the same act. The action was first considered by the district court on petitioner's motion for summary judgment based on respondent's answers to interrogatories and on affidavits and exhibits establishing the essential indisputable facts with regard to the products in issue and the manner in which they were advertised and sold.

After consideration of these evidentiary facts and additional undisputed evidentiary facts submitted by respondent, the district court granted petitioner's motion holding (App. B, *infra*, 2a-3a):

> "On the basis of the whole record; having in mind not only a comparison of the appearance, packaging, price and trade names of the two products involved herein, as shown in the exhibits, but also the nature of the products themselves, and the manner and conditions under which these two products are sold; and bearing in mind the effect which would be produced in the mind of the ordinary purchaser, exercising due care and caution, when confronted by the products singly presented; the Court is of the opinion that there is little likelihood that such a purchaser would be misled or deceived into accepting the product of the defendant for that of the plaintiff."

On respondent's appeal, the Court of Appeals for the Seventh Circuit reversed on the ground that the ultimate question of likelihood of confusion constituted *a disputed question of fact* that should not be determined in a summary judgment proceeding (App. B, *infra*, 7a). The action was remanded for a trial of this *fact* question (App. B, *infra*, 8a).

At the subsequent trial in the district court, the evidence was undisputed that both petitioner's and respondent's products are members of the large class of chemical compounds known as organic *amines* (i.e., derivatives of ammonia), and both are physiologically known as antihistamines (J. A. 66-67, 126-27, 216, 350-51, 430, 478, 480, 706, 847, D. A. 2a). There are thousands of organic amines (J. A. 478-79, 848-49, 899-900, Def. Exs. 52, 53). Indeed, the word "amine" is so common that it is defined in standard desk dictionaries, as well as in technical publications (J. A. 721, Def. Exs. 51B, 52, 53). Thus the amine suffix in petitioner's and respondent's trademarks is a well known technical term which accurately describes both the chemical and physiological nature of these products.

The evidence showed beyond question that for many years there had been a general custom in the pharmaceutical industry to use trademarks containing the descriptive "amine" suffix (J. A. 666-69, 722-27, 729, 855, 895-99, 1243-53). Among many others, such trademarks include APOLAMINE and TRIPAMINE—which are motion sickness remedies directly competitive with DRAMAMINE and BONAMINE (J. A. 56-57, 354, 729-30, 1243)—and SCOPOLAMINE, one of the earliest effective motion sickness remedies, which preceded DRAMAMINE and is still in use (J. A. 64, 773). Respondent's president admitted that "The name 'DRAMAMINE' was coined, as are all our tradenames, from the chemical formulation of the drug" (J. A. 900).

The evidence also showed that to avoid any possibility of confusion of its trademark with those used by competitors, petitioner coupled the "amine" suffix, which was

descriptive of its product, with a distinctive prefix "bon" which is a well-known French word meaning "good" (J. A. 223, 231). The significance of the prefix "bon" is completely different from that of the prefix "dram" of respondent's mark, which connotes a small unit of measure (J. A. 74, 170-71). It is to be noted that "bon" and "dram" do not have a single letter in common, or even the same number of letters.

On the foregoing evidence the district court held that the products in issue "are both members of the large and well-known chemical class of organic amines"; and that "numerous products which have been sold in drug stores for years contain the amine suffix", some of which are antihistamines and some are motion sickness remedies. It also held that "the words BONAMINE and DRAMAMINE are unlike" (J. A. 1278, App. B, *infra*, 10a, Findings Nos. 9-10).

Not only are the respective trademarks of the parties different, but the appearances of the products in issue and of the packages in which they are sold also are different. Petitioner's BONAMINE product is sold in the form of small, white, 25-milligram tablets, whereas respondent's DRAMAMINE product is sold in the form of large, yellow, 50-milligram tablets (Def. Ex. 1, 4A, B. 39). Petitioner's package features the blue and white color combination, with the distinctive name Pfizer prominently displayed across its face, which is standard for a large number of petitioner's products (Def. Ex. 3, 4A, 39, 41; J. A. 440-43). In contrast, respondent's package features its characteristic chocolate brown and robin's egg blue color combination, with the distinctive name Searle prominently displayed (Def. Ex. 1, 2, 4B; J. A. 49-51).

The district court found that "although neither of the tablets is particularly distinctive in appearance, they do differ from each other in color and in size. The packaging also differs" (J. A. 1279, App. B, *infra*, 11a, Finding No. 14).

The court of appeals brushed aside these facts, on the amazing ground that these differences between the products

"would not be helpful" in distinguishing them (Op. 5, App. B, *infra*, 17a). It then went on to hold that confusion is caused by the similarity between the sound of DRAMAMINE and the sound of BONAMINE, because these products are widely promoted and often purchased by word-of-mouth. Respondent had conceded in the district court that its case hinged upon the proposition that DRAMAMINE and BONAMINE sounded alike. Thus this question of acoustic similarity was the controlling fact issue throughout the trial, and it was recognized as the controlling issue by the court of appeals.

The evidence on this issue was in sharp conflict. Both parties produced expert witnesses whose testimony was directed to this specific question. Many other witnesses from various parts of the country pronounced these names on frequent occasions throughout their testimony.

Petitioner's speech expert was Dr. Hilda Fisher, a member of the faculty of Northwestern University, who explained to the trial court the numerous errors in the testimony of respondent's expert and then went on, by reference to (a) accepted rules of phonetics, (b) the speech habits of people from widely separated parts of the United States, and (c) standard dictionaries, to testify that the words BONAMINE and DRAMAMINE are most unlike one another and that in no part of the country would they be pronounced alike, regardless of the background of the person pronouncing them (J. A. 493-95). As clearly explained by Dr. Fisher in her testimony:

> Both DRAMAMINE and BONAMINE have the same suffix "amine", but there is a large body of words in our language which use this suffix.
>
> The first element of a word "normally is most vivid in the memory of a person who hears it or sees it".
>
> "There is no correspondence between the two stressed syllables, the first syllable of BONAMINE and the first syllable of DRAMAMINE."

The first element of each syllable "is a stop consonant, in the case of BONAMINE a 'B' and in the case of DRAMAMINE a 'D'. These are quite distinct. We use them to differentiate meanings in all sorts of words and in all positions of words. Such words as day and bay are quite clearly distinct. The words like rubber and rudder are quite clearly distinct, or, such a word as bid and bib."

"They look differently since the lips are used to make 'b' and the tongue is used to make 'd'. They sound differently.

"Next, there is an 'r' in the word DRAMAMINE. This is an 'r' which is inevitably pronounced. No matter what dialect a person were to live in he would pronounce this 'r', so it is an added phonemic element in this word which would distinguish it from BONAMINE.[2]

"Thirdly, there are the consonants which close the syllables. In BONAMINE there is an 'n' and in DRAMAMINE there is an 'm' and these again distinguish meaning in all sorts of words in all positions.

"The two vowels are different. In the speech of most American speakers the great majority would pronounce the 'o' of BONAMINE as an 'ah', as in 'father' and the 'a' of DRAMAMINE as an 'aa' as in 'hat'. This is the predominant pronunciation of these two vowels.

"Therefore, we have four distinct differences in the pronounciation of the two words."

After pointing out the many critical distinctions between the words BONAMINE and DRAMAMINE, Dr. Fisher concluded (J. A. 495) that they

"are significantly dissimilar"

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2. Although respondent's expert attempted to minimize the importance of this feature in his direct testimony, on cross-examination he admitted that the letter "r" before a vowel is always pronounced and that this letter in DRAMAMINE "does in fact help to distinguish it from BONAMINE" (J. A. 168).

At the conclusion of the trial the district court made the following findings (J. A. 1278, App. B, *infra*, 10a):

> "10. The words Bonamine and Dramamine are unlike. As [respondent] argued that the two words represented sounds which were acoustically similar and often confused, the Court devoted close attention to the two words as variously pronounced by counsel and witnesses throughout the proceedings. It is the finding of the Court that [respondent's] view is not supported by the evidence."

These findings squarely met the issues as to whether the marks were like one another, and whether their pronunciation was so similar as to be likely to cause confusion. The court of appeals discarded the first finding—that the marks were "unlike"—on the ground it was "clearly erroneous"; and it discarded the second finding—that the marks were not acoustically similar—on the ground it was based upon "a side by side comparison" which "is not a correct test" for such an issue (Op. 5, App. B, *infra*, 16a). In doing so it ignored the evidence which fully supported these findings; it ignored Rule 52(a) of the Federal Rules of Civil Procedure; and it established the amazing proposition that a trial judge under our system of jurisprudence cannot adjudicate issues of trademark infringement based on supposed acoustic similarity because listening to the pronunciation of the trademarks during the trial constitutes "a side by side comparison" of sounds, which is "not a correct test" for acoustic similarity.

Ironically enough, in holding that the marks sounded alike the appellate court was relying upon the very record which was before the district court, without benefit of hearing the marks as pronounced by the witnesses during the trial. Thus the "correct test" for acoustic similarity established by the court of appeals evidently excludes the use of the auditory sense.

REASONS FOR GRANTING THE WRIT.

1. The decision of the court of appeals is in direct conflict with (a) prior decisions of this Court, (b) prior decisions of its own, and (c) decisions of courts of other circuits. Indeed, the conflict is such that the action of the court of appeals in holding to be "clearly erroneous" findings of fact supported by substantial credible evidence adduced from witnesses who testified at the trial amounts to such a departure from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

Rule 52(a) F. R. C. P. (App. A, *infra*, 1a) provides that findings of fact made by the trial judge cannot be set aside unless they are "clearly erroneous", and due regard must be given to the opportunity of the trial court "to judge of the credibility of the witnesses". The controlling decisions leave no doubt that this language expressly forbids an appellate court from setting aside findings of fact which, as here, are supported by substantial evidence adduced during the trial.

In *Graver v. Linde*, 336 U. S. 271, 69 S. Ct. 535 (1949), this Court reversed the judgment of the same court of appeals because it mistakenly set aside findings of fact of the trial judge on the ground that they were erroneous. From the *Graver v. Linde* decision it is crystal clear that an appellate court must make allowance for the advantages possessed by the trial court in appraising the significance of conflicting testimony. And it cannot reverse on the ground that findings are "clearly erroneous" if they are supported by substantial evidence, 336 U. S. 274-275. These basic principles have formed the framework within which Rule 52(a) has subsequently been applied by the various appellate courts.

Following the *Graver v. Linde* case, the court below showed its awareness of the significance of Rule 52(a) in *Benrose Fabrics Corp. v. Rosenstein*, 183 F. 2d 355 (C. A.

7, 1950). It there made the following application of the *Graver v. Linde* doctrine, which has been frequently quoted and consistently applied by other courts (183 F. 2d at 358):

> "From the foregoing facts and certain others, some controverted and some undisputed, with which it is unnecessary to belabor this opinion, it seems clear to us that the evidence was of such character and weight as to support the findings and conclusions. We can conceive of no right upon our part to set them aside, for we cannot say, as a matter of law, that they are clearly erroneous. True, with other courts, we have announced that if findings rest upon documents, depositions or upon mere comparison of names, if credibility of witnesses is not involved, or if the trial tribunal has no opportunity to observe the witnesses, a court of review is as well qualified to pass upon the weight of evidence as is the trial court, but where, as here, conflicting stories are told by witnesses whose credibility is at stake, we may not supersede the determination of the finder of facts and substitute our judgment for his. It is not a question of whether we would have made the same finding; it is rather a question of whether the evidence substantially and adequately supports it."

A very recent trademark decision in another circuit is also in conflict with the decision of the court of appeals in the instant case. In *S. C. Johnson & Son, Inc. v. Johnson*, 121 USPQ 63 (C. A. 6, March 30, 1959), the court of appeals stated (page 73):

> "Where a district court's findings and conclusions that a defendant had no guilty knowledge or fraudulent intent to deceive or pass off its products as those of the plaintiff, that there would be no confusion, mistake, or likelihood thereof as to the source of origin of the parties' respective products, and that defendant's labels

or marks did not infringe plaintiff's trademark, were not clearly erroneous, but were supported by substantial credible evidence, an affirmance of a judgment for the defendant thereon is required."

We respectfully submit that the established principles set forth in the aforementioned cases were violated by the court of appeals when it disposed of the instant case by setting aside the express findings of the trial court (a) that the trademarks involved are "unlike" and (b) that they are "not acoustically similar".

2. The decision of the court of appeals also is in direct conflict with the decision in *Rohr Aircraft Corporation, et al. v. Rubber Teck Inc., et al.*, 121 USPQ 241 (C. A. 9, April 21, 1959). In that case the defendant's name DUO-SEAL was held not to infringe any of several registered trademarks including BOLT O SEAL. The court observed (page 247) that there were some 27 other trademarks registered in the Patent Office by different companies which contained the word "seal" as a suffix, and held that this word was "a descriptive term describing both the device of the plaintiff's and of the defendants", so it was not subject to exclusive appropriation in a trademark.

The decision below also is in direct conflict with decisions in other circuits to the same effect as the above-cited *Rohr Aircraft* case, including:

Pro-Phy-Lac-Tic Brush Co. v. Jordan Marsh Co., 165 F. 2d 549 (C. A. 1, 1948) involving JEWELITE and GEMLITE for toilet sets;

The Upjohn Company v. David Schwartz, 246 F. 2d 254 (C. A. 2, 1957) involving SYRACOL and CHERACOL for cough medicines; and

Pennzoil Co., et al. v. Crown Central Petroleum Corporation, 140 F. 2d 387 (C. A. 4, 1944) involving PENNZOIL and GREENZOIL for motor oils.

3. The court of appeals also so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision in a further respect.

The opinion of the court of appeals (Op. 3-4, App. B, *infra*, 15a) referred to Finding No. 10 of the district court (J. A. 1278, App. B, *infra*, 10a) and erroneously stated that there was "no other finding as to likelihood of confusion".[3] The court implied that, erroneous or not, this was an insufficient finding of fact, and it thereupon proceeded to resolve conflicting evidence and make its own contrary findings.

Under the applicable authorities, even if one assumes that the findings below were inadequate, the most that the court of appeals should have done was to send the case back for supplemental findings or a new trial. It should not have attempted to resolve disputed testimony, make independent findings of its own, and enter a judgment in respondent's favor. 3 Am. Jur. *Appeal and Error* § 1155, page 666.

The proper practice is illustrated by the same court of appeals in *Kweskin v. Finkelstein*, 223 F. 2d 677 (C. A. 7, 1955), wherein it remanded the case for further findings because the findings of the trial court were deemed inadequate. See also *Maher, et al. v. Hendrickson, et al.*, 188 F. 2d 700, 702 (C. A. 7, 1951).

This is not the unusual situation where the record shows there is no conflict in the evidence bearing on the material facts, and an appellate court is in just as good a position to find these facts as the trial court. Such a situation is illustrated by *National Biscuit Co. v. Kellogg Co.*, 91 F. 2d 150, 155 (C. A. 3, 1937) reversed on other grounds 305 U. S. 109 (1938).

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3. The record is to the contrary, and shows that the trial judge made additional findings of fact which directly bear on the question of likelihood of confusion. See Findings Nos. 9, 10, 14, and 15 (J. A. 1278-79, App. B, *infra* 10a-11a).

It is manifest from the record herein, and the disputed testimony referred to heretofore, that in the instant case the conflict in the evidence was so fundamental that the only course open to the court of appeals, if it regarded the findings made by the district court as inadequate, was to remand the case for supplemental findings or a new trial.

4. The questions presented are of great public importance because they involve the construction of the Trade-Mark Act of 1946 as applied to the issue of trademark infringement. This fundamental issue has never been considered by this Court, and the lower courts are in a state of uncertainty as to how questions of "likelihood of confusion" are to be resolved.

This uncertainty is manifest from the lists of cases cited by the court of appeals (Op. 6, App. B, *infra*, 17a-18a) wherein cases with similar suffixes but dissimilar prefixes were held (a) to be confusingly similar and (b) to be *not* confusingly similar. Following these lists the court of appeals commented:

> "In this type of litigation reference to decisions of courts as to other trademarks is not of great help."

Section 32(1) of the Trade-Mark Act of 1946 [15 U. S. Code § 1114(1)] (App. A, *infra*, 1a) gives a right of action based on the use, in commerce, of "any reproduction, counterfeit, copy, or colorable imitation of any registered mark" when such use is "likely to cause confusion or mistake or to deceive purchasers" as to the source of origin of the goods to which it is applied. Section 45 of the Act [15 U. S. Code § 1127] (App. A, *infra*, 1a) defines the term "colorable imitation" as including "any mark which so resembles a registered mark as to be likely to cause confusion or mistake or to deceive purchasers".

In the instant case, as we have shown, the key issue was whether, as respondent contends, the two trademarks are acoustically similar. The trial court, after hearing the

expert witnesses' testimony and listening to the pronunciations used by all witnesses and counsel throughout the proceedings, held they were not. The court of appeals held this amounted to a "side-by-side comparison" which, it said, is "not a correct test" (Op. 6, App. B, *infra*, 16a).

The Act nowhere establishes any test or furnishes any criteria for ascertaining when a mark is "likely to cause confusion or mistake". Accordingly, the uncertainty among the lower courts can be relieved only by this Court.

CONCLUSION.

For the foregoing reasons, this petition for certiorari should be granted.

Respectfully submitted,

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June 25, 1959.

APPENDIX A.

Excerpts From Patent Act of 1946 [Title 15, U.S. Code]

§ 2 [§ 1114] Remedies; infringement; innocent infringement by printers and publishers

(1) Any person who shall, in commerce, (a) use, without the consent of the registrant, any reproduction, counterfeit, copy, or colorable imitation of any registered mark in connection with the sale, offering for sale, or advertising of any goods or services on or in connection with which such use is likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such goods or services; * * * shall be liable to a civil action by the registrant for any or all of the remedies hereinafter provided in this chapter. * * *

§ 45 [§ 1127] Construction and definitions; intent of chapter

In the construction of this chapter, unless the contrary is plainly apparent from the context—

* * *

The term "colorable imitation" includes any mark which so resembles a registered mark as to be likely to cause confusion or mistake or to deceive purchasers.

* * *

Excerpt From Rule 52, F.R.C.P.

"FINDINGS BY THE COURT

"(a) Effect. In all actions tried upon the facts without a jury * * *, the court shall find the facts specially and state separately its conclusions of law thereon and direct the entry of an appropriate judgment; * * *. Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. * * *"

APPENDIX B.

IN THE UNITED STATES DISTRICT COURT
N. D. ILLINOIS, E. D.

No. 53 C 2407.

G. D. Searle & Co., a Corporation,
Plaintiff,

v.

Chas. Pfizer & Co., Inc., a Corporation,
Defendant.

March 7, 1955.

Opinion.

KNOCH, *District Judge.*

This matter came on to be heard on the defendant's motion for summary judgment in its favor.

The Court has carefully considered the entire record, including the motion itself and the affidavits and exhibits submitted in support of and in opposition to the motion, as well as additional evidence bearing on the manner and conditions of sale. The Court has had the benefit of extensive argument of counsel presented orally and in briefs and memoranda, has studied the authorities to which reference has been made, and is fully advised in the premises.

On the basis of the whole record; having in mind not only a comparison of the appearance, packaging, price and trade names of the two products involved herein,[1] as shown

1. Dramamine and Bonamine.

in the exhibits, but also the nature of the products themselves, and the manner and conditions under which these two products are sold; and bearing in mind the effect which would be produced in the mind of the ordinary purchaser, exercising due care and caution, when confronted by the products singly presented; the Court is of the opinion that there is little likelihood that such a purchaser would be misled or deceived into accepting the product of the defendant for that of the plaintiff.

As plaintiff's allegation of unfair competition is dependent on the charge of colorable imitation of plaintiff's trademark, it requires no further consideration.

The defendant's motion for summary judgment in its favor will, therefore, be granted. An order in conformity with the foregoing may be presented within 5 days.

Appendix B

IN THE UNITED STATES COURT OF APPEALS
SEVENTH CIRCUIT.

No. 11460.

G. D. Searle & Co.,
Plaintiff-Appellant,

v.

Chas. Pfizer & Co., Inc.,
Defendant-Appellee.

March 20, 1956.

Opinion.

DUFFY, *Chief Judge.*

This is an appeal from a summary judgment in favor of the defendant in an action for trade-mark infringement and unfair competition. The trademarks involved are Dramamine used by plaintiff, and Bonamine used by defendant. Both are used as preventives or remedies for motion sickness.

Plaintiff adopted the trademark "Dramamine" in 1948. It expended more than $2,000,000 in advertising and promoting "Dramamine" as a motion sickness preventive and remedy. At the time of the filing of this suit, sales of this item had exceeded $10,000,000. Plaintiff registered its trademark "Dramamine" in the United States Patent Office in 1950.

Defendant adopted and began the use of the trademark "Bonamine" in August, 1953. It claims to have expended $700,000 in sales promotion, and that total sales of "Bonamine" had exceeded $900,000 by September 8, 1954. This action was filed December 16, 1953.

The summary judgment herein was proper only if the pleadings, depositions and admissions on file, together with the affidavits, showed there was no genuine issue as to any material fact. Rule 56, Federal Rules of Civil Procedure, 28 U.S.C.A. Albert Dickinson Co. v. Mellos Peanut Co., 7 Cir., 179 F.2d 265.

To sustain an action for trademark infringement and unfair competition "* * * it is not necessary to show actual cases of confusion since the test under the statute, 15 U.S.C.A. § 1114(1), is likelihood of such confusion." Independent Nail & Packing Co., Inc., v. Stronghold Screw Products, Inc., 7 Cir., 205 F.2d 921, 925; Keller Products, Inc., v. Rubber Linings Corp., 7 Cir., 213 F.2d 382, 386.

Plaintiff filed affidavits of thirteen physicians, twelve pharmacists, four airline hostesses and three members of the public, dealing with the question of likelihood of confusion between Dramamine and Bonamine. On this point, defendant filed two affidavits each by Thomas G. Bradley, its Director of Sales and Promotion.

The first Bradley affidavit, dated May 13, 1954, detailed the steps taken by the defendant in introducing Bonamine to the trade and explained its chemical ingredients. On the question of likelihood of confusion the affidavit stated:

> "Although any and all instances of confusion between Bonamine and any other pharmaceutical product coming to the attention of Pfizer's salesmen throughout the country should be reported to me, I have not received a single report of this nature to date. This confirms my conviction that there is no reasonable likelihood of confusion, mistake or deception between the products Dramamine and Bonamine."

In the second affidavit, filed September 28, 1954, affiant makes this further statement:

> "* * * Pfizer salesmen throughout the country have been under instructions to report any instances of confusion between the products Bonamine and Dramamine. Despite the increased sales of Bonamine, I have not received a single report of this nature to date."

Rule 56(e), Federal Rules of Civil Procedure, 28 U.S.C.A. provides that affidavits may be filed in support of and in opposition to a motion for summary judgment, and in mandatory terms prescribes as follows:

> "(e) Supporting and opposing affidavits shall be made on personal knowledge, shall set forth such facts as would be admissible in evidence, and shall show affirmatively that the affiant is competent to testify to the matters stated therein. * * *".

The statements above quoted made in the affidavits of the defendant's Director of Sales and Promotion constitute defendant's showing as to likelihood of confusion between the products Bonamine and Dramamine. Such showing constitutes merely expressions of affiant's opinion and his legal conclusion.

Under Rule 56(e), such expressions are totally ineffectual, and are not to be given any consideration or weight whatsoever. Sartor v. Arkansas Natural Gas Corp., 321 U.S. 620, 627-628, 64 S.Ct. 724, 88 L.Ed. 967; Jameson v. Jameson, 85 U.S.App.D.C. 176, 176 F.2d 58, 60; United States v. Britten, 3 Cir., 161 F. 2d 921, 928; Subin v. Goldsmith, 2 Cir., 224 F.2d 753, 756-758; Williams v. Kolb, 79 U.S.App.D.C. 253, 145 F.2d 344; State of Washington v. Maricopa County, 9 Cir., 143 F.2d 871, 872; Walling v. Fairmount Creamery Co., 8 Cir., 139 F.2d 318, 323; F.A.R. Liquidating Corp. v. Brownell, 3 Cir., 209 F.2d 375, 379-380. Affidavits which are inadequate under Rule 56(e) must be disregarded. Automatic Radio Manufacturing Co., Inc.,

v. Hazeltine Research, Inc., 339 U.S. 827, 831, 70 S.Ct. 894, 94 L.Ed. 1312.

Since the portions of the Bradley affidavits dealing with likelihood of confusion between Dramamine and Bonamine must be disregarded, we examine the balance of the record to ascertain if there is any other basis for the summary judgment which was entered.

The ultimate determination of consumer confusion is a question of fact. Albert Dickinson Co. v. Mellos Peanut Co. of Illinois, 7 Cir., 179 F.2d 265, 269; Coca-Cola Co. v. Snow Crest Beverages, Inc., 1 Cir., 162 F.2d 280, 283; Skinner Mfg. Co. v. Kellogg Sales Co., 8 Cir., 143 F.2d 895, 899; William R. Warner & Co. v. Eli Lilly & Co., 265 U.S. 526, 529, 44 S.Ct. 615, 68 L.Ed. 1161. "The ultimate question is always whether or not the public is likely to be deceived; and this is a question of fact, depending on all the attendant circumstances." Federal Glass Co. v. Loshin, 2 Cir., 224 F.2d 100, 101. All doubts as to whether there is a fact issue must be resolved against the moving party. Griffeth v. Utah Power & Light Co., 9 Cir., 226 F.2d 661, 669; Toebelman v. Missouri-Kansas Pipe Line Co., 3 Cir., 130 F.2d 1016, 1018; Weisser v. Mursam Shoe Corporation, 2 Cir., 127 F.2d 344, 346, 145 A.L.R. 467.

Plaintiff's answers to interrogatories show only that prior to March 1, 1954, cases of actual confusion had not come to the attention of officials of plaintiff, but this was prior to the survey which plaintiff conducted in August and September of that year. Furthermore, in said answers, plaintiff insisted that the likelihood of confusion did exist.

At the oral argument some point was made of the fact that at the time this action was commenced it was necessary to obtain a doctor's prescription for the ultimate consumer to obtain either Dramamine or Bonamine. However, proof was made that prior to the time when judgment was entered permission had been granted by the Department of Health, Education and Welfare to sell Dramamine in over-the-counter sales without prescription. Some inti-

mation was made that Bonamine could now or soon would be available in the same manner. What the fact is may be of importance on the question of consumer confusion. However, the District Court made no findings on this point, and this is only another indication as to why the case at bar should be decided on the merits after a trial, and not disposed of by summary judgment.

The judgment of the District Court is reversed and the cause remanded.

IN THE UNITED STATES DISTRICT COURT
N. D. ILLINOIS, E. D.

No. 53 C 2407.

G. D. Searle & Co., a Corporation,
Plaintiff,

v.

Chas. Pfizer & Co., a Corporation,
Defendant.

Feb. 3, 1958.

Findings of Fact and Conclusions of Law.

KNOCH, *District Judge.*

The Court has reviewed the record and briefs of counsel, has considered the authorities cited, and upon a consideration of the whole case makes the following:

Findings of Fact

1. Plaintiff is a corporation of Illinois, with its principal place of business at Skokie, Illinois. Defendant is a corporation of Delaware, with its principal place of business at Brooklyn, New York.

2. The amount in controversy between the parties exceeds the sum of $3,000, exclusive of interest and costs.

3. This is an action for trademark infringement and unfair competition based upon the alleged violation of plaintiff's rights in the Dramamine trademark because of defendant's use of its Bonamine trademark. Both of these trademarks are applied to pharmaceutical products which may be described as antihistamines which are used as motion-sicken remedies.

4. In 1947, plaintiff developed a pharmaceutical product, the descriptive name of which is dimenhydrinate.

5. On March 3, 1949, dimenhydrinate was released for sale on prescription.

6. Since 1949, plaintiff has manufactured, distributed, and sold, and is now selling, dimenhydrinate as a remedy for the prevention and treatment of motion sickness.

7. Plaintiff has sold dimenhydrinate under the trademark Dramamine since the product was first released for sale.

8. On or about December 1, 1953, defendant's motion sickness remedy, parachloramine, was released for sale upon prescription under the name Bonamine.

9. The products in issue are both members of the large and well-known chemical class of organic amines. The record shows that numerous products which have been sold in drugstores for years contain the amine suffix. Some of these products are antihistamines and some of them are motion sickness remedies. Some antihistamines are useful as motion sickness remedies.

10. The words Bonamine and Dramamine are unlike. As plaintiff argued that the two words represented sounds which were acoustically similar and often confused, the Court devoted close attention to the two words as variously pronounced by counsel and witnesses throughout the proceedings. It is the finding of the Court that plaintiff's view is not supported by the evidence.

11. Plaintiff had knowledge of defendant's intention to adopt Bonamine as a trademark for an antihistamine months before defendant committed itself to this mark.

12. On or about November 10, 1954, plaintiff was authorized by the Food and Drug Administration to sell the product sold under the trademark Dramamine over the counter without prescription.

13. On or about November 29, 1955, defendant was authorized by the Food and Drug Administration to sell the product sold under the trademark Bonamine over the counter without prescription.

14. Although neither of the tablets is particularly distinctive in appearance, they do differ from each other in color and size. The packaging also differs. It is plaintiff's contention that a confusing similarity exists not in physical appearance or dress but between the spoken sound and the appearance in print of the coined words constituting the two trademarks.

15. Physicians, pharmacists and users of medicine generally exercise a high degree of caution. Medicines for internal consumption to alleviate ills (as contrasted with confections or cleaners, for example) are purchased with great care.

16. The charge of trade disparagement is based upon an error in one of defendant's advertisements, which is attributable to an employee of an independent trade publication in which the advertisement appeared. The same advertisement, free from the error in question, appeared in numerous other trade publications at about the same time. There was no reference to plaintiff or its product in the erroneous advertisement, and the statement of which complaint is made, while not completely accurate, was within the bounds of permissible "puffing." Plaintiff was not damaged by this advertisement.

Conclusions of Law

1. The Court has jurisdiction of the parties and of the subject-matter of this action.

2. Defendant has not infringed plaintiff's Dramamine trademark or unfairly competed with plaintiff.

3. Plaintiff's charge of trade disparagement is without merit.

4. The complaint should be dismissed.

IN THE UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

No. 12321 SEPTEMBER TERM, 1958, JANUARY SESSION, 1959.

G. D. Searle & Co.,
Plaintiff-Appellant,

v.

Chas. Pfizer & Co., Inc.,
Defendant-Appellee.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF ILLINOIS, EASTERN DIVISION.

March 26, 1959.

Opinion.

Before DUFFY, *Chief Judge* and HASTINGS and PARKINSON, *Circuit Judges.*

DUFFY, *Chief Judge.* This is an appeal from a judgment of the District Court dismissing plaintiff's action for infringement of a registered trademark and for unfair competition. The trademarks in this controversy are "Dramamine" used by plaintiff and "Bonamine" used by defendant. The trademarks are used for motion sickness remedies or preventives. These products are now sold to the general public without a physician's prescription.

In 1947 plaintiff developed a pharmaceutical product for use in the prevention and treatment of motion sickness. It adopted the coined and fanciful trademark "Dramamine." Tests were conducted in cooperation with the Surgeon General of the Army and doctors at Johns Hopkins Hospital which established the product's effectiveness both in the prevention and treatment of motion sickness. On February 14, 1949, the Surgeon General released a report of the results of these tests which received wide and favorable publicity. On March 3, 1949, Dramamine was released for sale by prescription. Prior to December 1, 1953, plaintiff's sales of Dramamine exceeded $12,000,000.00. About November 10, 1954, plaintiff was authorized to sell Dramamine over the counter without a prescription.

Plaintiff has sold its motion sickness remedy under the trademark "Dramamine" ever since it was placed on the market. It registered "Dramamine" as the trademark in the United States Patent Office on July 18, 1950, and the mark was given Registration No. 527862. The registration has become incontestable. 15 U.S.C. § 1065.

About July 1, 1953, defendant purchased the United States rights to a product known as U.C.B. 5062 which had been developed by a Belgian manufacturer and sold in Europe as a motion sickness remedy under the trademark "Postafene." Defendant requested certain of its employees to suggest a trademark for U.C.B. 5062, informing them the product was "to be indicated for use in motion-sickness and is competitive with Dramamine." One hundred fifty-eight names were suggested. From this long list defendant selected the name "Bonamine." Dr. Moore, a phonetics expert, testified that Bonamine was more like Dramamine than any other word on the list.

A somewhat similar situation existed in *Q-Tips, Inc. v. Johnson & Johnson*, 3 Cir., 206 F.2d 144, where the defendant was confronted with the trademark "Q-Tips." The court said, page 147: "The evidence shows a list of dozens of names suggested by various employees, many of

which are arbitrary, fanciful and completely unlike anything suggested by the plaintiff's product. But in the end defendant's top management came up with the name under discussion, 'Cotton Tips'. It is quite clear why, with all the possibilities open to it, defendant made this choice. • • •"

Defendant, a late-comer in the field, knew of plaintiff's use of the trademark Dramamine, and of the predominant position of Dramamine in the market at the time it chose to compete with its product which it designated as Bonamine. Defendant recognized this predominant position the following year when it issued instructions to salesmen stating "Dramamine has been on the market for a number of years and has been intensely promoted; consequently its biggest advantage now is that physicians have the Dramamine habit."

The statement which we made a number of years ago in *Northan Warren Corp. v. Universal Cosmetic Co.*, 7 Cir., (1927), 18 F.2d 774, 775, is a good and safe rule to follow: "One entering a field of endeavor already occupied by another should, in the selection of a tradename or trade-mark, keep far enough away to avoid all possible confusion. • • •"

Many products competitive to Dramamine came upon the market. On July 25, 1955, a district representative of Pfizer sent out a sales letter which contained the following: "The motion sickness market is a tremendous market running into millions and millions of dollars. At the present time, the bulk of this market is enjoyed by one of our competitors • • • your competition is Dramamine. • • •"

The trademark Dramamine is non-descriptive. In *G. D. Searle & Co. v. Institutional Drug Distributors, Inc.*, 141 F. Supp. 838, 839, Chief Judge Yankwich referred to Dramamine as "• • • a strong, non-descriptive and valid mark, used to designate tablets of Dimenhydrinate • • •" The same judge in *G. D. Searle & Co. v. Institutional Drug Distributors, Inc.*, 151 F. Supp. 715, 717, again referring

to Dramamine said: "The mark is not descriptive. By all standards it is a strong mark. • • • Marks of this character, especially when exploited on a national basis, have been given the highest protection by the courts both before and since the enactment of the Lanham Act. 15 U.S.C.A. §§ 1051, 1127. • • •" We agree with Judge Yankwich's statements.

Finding of Fact 10 states, "The words Bonamine and Dramamine are unlike. As plaintiff argued that the two words represented sounds which were acoustically similar and often confused, the Court devoted close attention to the two words as variously pronounced by counsel and witnesses throughout the proceedings. It is the finding of the Court that plaintiff's view is not supported by the evidence." There was no other finding as to likelihood of confusion.

That part of the finding which states Dramamine and Bonamine are unlike is clearly erroneous. Dramamine and Bonamine contain the same number of syllables; they have the same stress pattern, with primary accent on the first syllable and secondary accent on the third; the last two syllables of Dramamine and Bonamine are identical. The initial sounds of Dramamine and Bonamine ("d" and "b") are both what are known as "voiced plosives" and are acoustically similar; the consonants "m" and "n" are nasal sounds and are acoustically similar. The only dissimilar sound in the two trademarks is the "r" in Dramamine. Slight differences in the sound of similar trademarks will not protect the infringer. *Lambert Pharmacal Co. v. Bolton Chemical Corp.*, 219 Fed. 325, 326.

Finding 10 seems to indicate that the trial court was of the view it was plaintiff's burden to prove that the words "Dramamine" and "Bonamine" were often confused. Such is not the correct test in determining whether a trademark has been infringed. When this case was here before, we said, 231 F.2d 316, 317: "• • • it is not necessary to show actual cases of confusion since the test under

the statute, 15 U.S.C.A. § 1114(1), is likelihood of confusion." We cited *Independent Nail & Packing Company, Inc. v. Stronghold Screw Products, Inc.*, 7 Cir., 205 F.2d 921, 925, and *Keller Products, Inc. v. Rubber Linings Corp.*, 7 Cir., 213 F.2d 382, 386.

Section 2 of the Trade-Mark Act of 1946, 15 U.S.C.A. § 1114(1), gives the holder of a trademark, such as plaintiff, a right of action against "Any person who shall, in commerce, (a) use, without the consent of the registrant, any * * * colorable imitation of any registered mark in connection with the sale, offering for sale, or advertising of any goods * * * on or in connection with which such use is likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such goods * * *."

Section 45 of that Act (15 U.S.C.A. § 1127) defines "colorable imitation" to include "any mark which so resembles a registered mark as to be likely to cause confusion or mistake or to deceive purchasers." Thus, it is clear that the test is likelihood of confusion and not the quantity of actual confusion.

Although plaintiff proved several instances of actual confusion, such proof is not required. Defendant's reliance on *Rytex Co. v. Ryan*, 7 Cir., 126 F.2d 952 is misplaced. That case does not express the rule in this circuit. In *Barbasol v. Jacobs*, 160 F.2d 336, 340, we said "* * * we are convinced that our holding in the *Rytex* case pertinent to the instant question was an erroneous statement of law."

That part of Finding 10 which states the court devoted close attention to the pronunciation of the two names by counsel and witnesses was, in effect, a side by side comparison. This is likewise not a correct test. This Court has discussed the frailty of such tests in *Colburn v. Puritan Mills, Inc.*, 108 F.2d 377, 378, and *Albert Dickinson Co. v. Mellos Peanut Co. of Illinois*, 179 F.2d 265, 269. In these two cases we stated the rule recognized in this circuit, *viz.*, we must determine the purchasing public's

state of mind when confronted by somewhat similar trade-names *singly* presented.

Since it is the effect upon prospective purchasers that is important, the conditions under which they act must be considered. *Albert Dickinson Co. v. Mellos Peanut Co. of Illinois*, 179 F.2d 265, 270.

The trademarks "Dramamine" and "Bonamine" designate products which have identical uses; are sold to the public through the same channels of trade; are widely promoted by word-of-mouth advertising and often are purchased through oral or telephone requests. The two products are sold to the same class of customers. All sales are made without direct advertising to the ultimate consumer. On a dosage basis, the two products are priced competitively. Each product is produced by a well-known pharmaceutical manufacturer.

Defendant argues Bonamine is a white tablet while Dramamine is yellow and that the shape and size of the bottle containers are different. Such differences would not be helpful in distinguishing between the products, as they are usually sold. In any event, such differences would not be controlling, for it is the similarity of the sound of Dramamine and Bonamine, and the methods used for promotion and marketing, that make for confusion.

Defendant cites a number of cases where the trademarks involved had similar suffixes but dissimilar prefixes and where the marks were held to be not confusingly similar. Some of the cases cited are: *Pennzoil Co. v. Crown Central Petroleum Corp.*, 4 Cir., 140 F.2d 387, involving the marks "Pennzoil" and "Greenzoil" for motor oil; *Syncromatic Corp. v. Eureka Williams Corp.*, 7 Cir., 174 F.2d 649, involving the marks "Syncromatic" and "Oil-O-Matic" for oil burning heaters; *Kensington Steel Co. v. Nichols Engineering and Research Corp.* (C.C.P.A.), 188 F.2d 397, involving the marks "Nercalloy" and "Oroloy" for metal castings; and *Upjohn Co. v. Schwartz*, 2 Cir., 246 F.2d 254, involving the marks "Syrocol" and "Cheracol."

A long list of cases could be cited where trademarks with dissimilar prefixes but with similar suffixes had been held to be confusingly similar. Typical are: "Q-Tips" and "Cotton Tips", *Q-Tips, Inc. v. Johnson & Johnson*, 3 Cir., 206 F.2d 144; "LaTouraine" and "Lorraine", *La-Touraine Coffee Co. Inc. v. Lorraine Coffee Co. Inc.*, 2 Cir., 157 F.2d 115; "Peroxogen" and "Dioxogen", *Bookman v. Oakland Chemical Co.* (C.C.P.A.) 40 F.2d 1006; "Anacin" and "Alycin", *William S. Merrell Co. v. Anacin Co.* (C.C.P.A.) 109 F.2d 339; "Miracle Whip" and "Salad Whip", *Kraft Cheese Co. v. Leston Co.*, 43 F.Supp. 782; "Cytamin" and "Dent-A-Min", *McKesson & Robbins, Inc. v. American Foundation for Dental Science*, (C.C.P.A.) 150 F.2d 420. In a case involving Simoniz and Permanize, the court pointed out that the only material difference was in the first syllable of each word, and the court stated: "* * * this court has repeatedly held that the public ought not to be required to dissect and analyze trademarks in order that confusion and deception might be avoided." *Simoniz Co. v. Permanizing Stations of America, Inc.*, (C.C.P.A.), 49 F.2d 846, 847.

In this type of litigation reference to decisions of courts as to other trademarks is not of great help. Citation of individual cases can only indicate a general pattern. Often the background of the adoption of the mark is of importance on the question of intent. The evidence as to actual confusion or likelihood of confusion differs widely from case to case. However, courts are alert to protect the purchasing public from the conduct of business concerns which do not hesitate to trade upon the good name and the success of a competitor. We think the evidence in this case compels a holding that the trademark "Bonamine" is likely to cause confusion and mistake among purchasers of drugs who seek relief from motion sickness. Defendant adopted the name "Bonamine" apparently with the idea of getting as close to "Dramamine" as was legally possible, but we hold the evidence in this case discloses that defendant got too close.

Defendant claims that plaintiff had knowledge of defendant's announcement of its intention to use the Bonamine trademark in August, 1953, but made no objection until after defendant had spent considerable sums in popularizing its product. In effect, defendant urges laches. The trial court made no finding on this point.

Defendant did announce its intention to use the trademark Bonamine by publication of the fact in what is known as The Combined Trade-Mark Bureau. A manufacturer may register a trademark with the Bureau which then publishes it in a bulletin circulated to the trade. The Bureau does not approve trademarks.

Although defendant listed Bonamine with the Bureau, it described Bonamine merely as an antihistamine. At that time defendant had determined that the therapeutic use of Bonamine was to be as a motion sickness remedy. In a broad sense, Bonamine, was an antihistamine, but defendant has never promoted and never planned to promote Bonamine as a general purpose antihistamine.

In November, 1953, plaintiff learned that defendant was using Bonamine as a motion sickness remedy. Plaintiff promptly protested and then started this action on December 16, 1953. Under the circumstances of this case there was no estoppel by laches.

We hold that plaintiff is entitled to an injunction restraining defendant from using Bonamine as a trademark for a motion sickness remedy. However, we do not think that there should be a reference for an accounting or an award of damages.

In this case there was proof of but two instances of "palming off", *and these were by dealers.* It was inherently impossible to prove more than a few instances of actual confusion. A purchaser who has been confused as to a product such as a drug tablet usually makes no complaint that can be traced or, in some instances as shown by the evidence in the instant case, does not learn of the mistake until many months later.

Defendant will suffer a substantial loss by the injunction restraining the use of Bonamine as a trademark. This litigation has now been in the courts over five years. A further controversy on the question of damages may well prolong this litigation for another five years. No one but the lawyers could benefit by such a course. Balancing the equities, we think justice will be served by restraining defendant prospectively from the use of the trademark Bonamine as a motion sickness remedy. See *Q-Tips, Inc. v. Johnson & Johnson*, 3 Cir., 206 F.2d 144, 148; *Champion Spark Plug Co. v. Sanders*, 331 U.S. 125, 131.

Judgment reversed with instructions to issue an injunction restraining prospectively the defendant from using the trademark Bonamine to indicate a product useful for or to be used as a motion sickness remedy or preventive.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1959.

No. 142

CHAS. PFIZER & CO., INC.,
Petitioner,

vs.

G. D. SEARLE & CO.,
Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

BRIEF FOR RESPONDENT IN OPPOSITION.

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THE GUNTHORP-WARREN PRINTING COMPANY, CHICAGO

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